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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,393	12/03/2003	Ajay Gupta	48354-0001-00-US (228150)	5022
23973 7590 03/17/2009 DRINKER BIDDLE & REATH ATTN: INTELLECTUAL PROPERTY GROUP ONE LOGAN SQUARE 18TH AND CHERRY STREETS PHILADELPHIA, PA 19103-6996			EXAMINER FOREMAN, JONATHAN M	
			ART UNIT 3736	PAPER NUMBER
			MAIL DATE 03/17/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/725,393	<b>Applicant(s)</b> GUPTA, AJAY	
	<b>Examiner</b> JONATHAN ML FOREMAN	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 December 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,4-14,17-25,28,30-42,44-51,53,55 and 58-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-14,17-25,28,30-42,44-51,53,55,58-61 and 63 is/are rejected.
- 7) ☒ Claim(s) 62,64 and 65 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114.

Applicant's submission filed on 12/19/08 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 28, 30 - 42, 44 - 53 and 51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 28, 42 and 51 have been amended to include the limitation "selecting the second mode of the device to the exclusion of the first mode of the device". However, no disclosure of "selecting the second mode of the device to the exclusion of the first mode" can be found in the specification. The specification sets forth operating the device in a first or second mode, but does not set forth one mode excluding another mode.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4 – 14, 17 - 25, 28, 30, 32, 34, 36 – 42, 44 – 47, 49, 51, 53, 55, 58 and 63 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,002,065 to LaCourse et al. in view of U.S. Patent Application Publication No. 2006/0152382 to Hiltunen and U.S. Patent No. 6,478,736 to Mault.

In regard to claims 1, 4 – 14, 17 - 25, 55, 58 and 63, LaCourse et al. disclose a medical diagnostic apparatus including a component (103) for generating and displaying quantified vibration to be used in a medical diagnosis. The component generates vibration of a fixed magnitude or of a variable magnitude in a linear manner (Col. 3, line 53 – Col.4, line 56). The component generates vibration of a selected magnitude at a fixed frequency or of a variable frequency. The component generates a plurality of sets each of a fixed magnitude or frequency (Col. 3, line 53 – Col.4, line 56). When the apparatus is applied to a subject, threshold for the perception or disappearance of vibration can be determined as a measure of nerve function to detect neuropathy (Col. 5, lines 58 – 60). LaCourse et al. disclose the apparatus being a computer based device, but fail to disclose the component having a mode selector for selecting between a first mode of vibration and a second mode of vibration, wherein the device operates as a portable electronic device from the group consisting of a cellular phone, pager and beeper and the vibratory component generates vibration in a first mode in response to a remote wireless signal. However, Mault teaches a diagnostic computer based system. Mault further teaches that in addition to being a computer based system, the system can be a portable electronic device operable as a cellular phone, pager and beeper (Col. 6, lines 13 – 20) that has a first and second functionality (Col. 6, lines 4 – 8). Hiltunen discloses a cellular phone

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having a vibratory component that generates a vibration in response to a remote wireless signal in a first mode and to produce a vibration in a second mode [0030]. The vibratory component can generate vibration at a plurality of frequencies (Figure 4). Hiltunen discloses a mode selector for selecting between the first and second modes [0048]. Hiltunen discloses a probe projecting outwardly from the outer casing of the phone for transmitting vibration from the vibratory component [0032]. The claims would have been obvious because a particular known technique was recognizes as part of the ordinary capabilities of one skilled in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to apply the technique of combining a diagnostic and communication apparatus as taught by Mault to improve the vibratory screening and diagnostic system as disclosed by LaCourse et al. for the predictable result of having a functioning computer based diagnostic system that can be used as a portable communication device.

In regard to claims 28, 30, 32, 34, 36 – 42, 44 – 47, 49, 51, 53, LaCourse et al. disclose a method including providing a medical diagnostic apparatus including and a component (103) for generating vibration to be used in a medical diagnosis. LaCourse et al. disclose generating vibration and applying the apparatus to the extremity of a subject (Col. 3, lines 43 – 46); and diagnosing neuropathy based on detection or non-detection of vibration by the subject (Col. 5, lines 58 – 60). LaCourse et al. discloses determining a threshold for the subject's ability to detect vibration of a predetermined magnitude or frequency. LaCourse et al. discloses determining a perception threshold for the subject's ability to detect vibration by increasing the magnitude or frequency of vibration. LaCourse et al. discloses determining a disappearance threshold for the subject's ability to no longer detect vibration by decreasing the magnitude or frequency of vibration (Col. 3, line 53 – Col.4, line 56). The vibration includes a predetermined magnitude or frequency equal to about 95<sup>th</sup> – 97<sup>th</sup> percentiles of a normal population. LaCourse et al. discloses a fixed magnitude or frequency

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or a variable magnitude or frequency (Col. 3, line 53 – Col.4, line 56). LaCourse et al. disclose the apparatus being a computer based device, but fail to disclose the component having a mode selector for selecting between a first mode of vibration and a second mode of vibration, wherein the device operates as a portable electronic device from the group consisting of a cellular phone, pager and beeper and the vibratory component generates vibration in a first mode in response to a remote wireless signal. However, Mault teaches a diagnostic computer based system. Mault further teaches that in addition to being a computer based system, the system can be a portable electronic device operable as a cellular phone, pager and beeper (Col. 6, lines 13 – 20) that has a first and second functionality (Col. 6, lines 4 – 8). Hiltunen discloses a cellular phone having a vibratory component that generates a vibration in response to a remote wireless signal in a first mode and to produce a vibration in a second mode [0030]. The vibratory component can generate vibration at a plurality of frequencies (Figure 4). Hiltunen discloses a mode selector for selecting between the first and second modes [0048]. Hiltunen discloses a probe projecting outwardly from the outer casing of the phone for transmitting vibration from the vibratory component [0032]. The claims would have been obvious because a particular known technique was recognizes as part of the ordinary capabilities of one skilled in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention to apply the technique of combining a diagnostic and communication apparatus as taught by Mault to improve the vibratory screening and diagnostic system as disclosed by LaCourse et al. for the predictable result of having a functioning computer based diagnostic system that can be used as a portable communication device.

6. Claims 31, 33, 35, 48, 50 and 59 - 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,002,065 to LaCourse et al. in view of U.S. Patent Application

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Publication No. 2006/0152382 to Hiltunen and U.S. Patent No. 6,478,736 to Mault as applied above, and further in view of US Patent No. 5,931,793 to Laudadio.

In regard to claims 31, 33, 35, 48 and 50, LaCourse et al. in view of Hiltunen and Mault disclose determining a vibration threshold in order to diagnose a medical condition, but fail to disclose grading the threshold low, medium, or high when compared to a preset standard thereby indicating the severity of the medical condition. However, Laudadio discloses determining a vibration threshold and grading the threshold low, medium, or high when compared to a preset standard thereby indicating the severity of the medical condition (Col. 3, lines 18 – 25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method as disclosed by LaCourse et al. and Hiltunen and Mault to grade the vibration threshold low, medium, or high when compared to a preset standard as taught by Laudadio in order to quantify minimal impairment, moderate neuropath and severe neuropathy (Col. 3, lines 18 – 25).

In regard to claims 59 – 61, LaCourse in view of Hiltunen and Mault fail to disclose the vibratory component comprising a piezoelectric transducer (Col. 1, line 67) or a DC motor, a vibrating head adapted to be applied to the extremity of a subject, and a shaft transmitting a vibration from the motor to the head. Laudadio discloses a vibratory component comprising a piezoelectric transducer or a DC motor, a vibrating head adapted to be applied to the extremity of a subject, and a shaft transmitting a vibration from the motor to the head, the shaft comprises an offset weight thereon (Col. 3, lines 44 – 45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device as disclosed by LaCourse in view of Mault to include a vibratory component as taught by Laudadio in order to transfer a vibration to a patient.

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***Response to Arguments***

7. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

***Allowable Subject Matter***

8. Claims 62, 64 and 65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. U.S. Patent No. 6,978,164 to Vicendese discloses a vibratory probe projecting outwardly from a casing of a cellular phone.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JONATHAN ML FOREMAN whose telephone number is (571)272-4724.

The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M. F./  
Examiner, Art Unit 3736

/Max Hindenburg/  
Supervisory Patent Examiner, Art Unit 3736